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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,744	01/30/2004	Christian Bauer	713-1004	5715

33712 7590 12/17/2004

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EXAMINER

WUJCIAK, ALFRED J

ART UNIT PAPER NUMBER

3632

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/767,744

Applicant(s)

BAUER, CHRISTIAN

ST

Examiner

Alfred Joseph Wujciak III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-20 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 30 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/30/04 & 10/20/04.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This is the first Office Action for the serial number 10/767,744, RETAINING MEMBER, filed on 1/30/04.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 10/20/04 was filed after the mailing date of the filing date on 1/30/04. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Specification

The disclosure is objected to because of the following informalities: claim 19, line 3, "duct" is cited but not explained in the specification. The examiner needs to know what is the relationship for duct with the contact area and lining.

Appropriate correction is required.

Claim Objections

Claims 10-12 are objected to because of the following informalities: Claim 10, line 2, "seating (40)" should be ---seating (4)--- for clarification. Appropriate correction is required.

Claims 11-12 are rejected as depending on rejected claim 10.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

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Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 and 7 of copending Application No. 10/767,745 in view of US Patent # 6,708,931 to Miura. Application '745 teaches the retaining member comprising a basic body with a mounting area and a retaining area with at least one line seating.

The application '745 teaches the mounting area but fails to teach the resilient contact area projecting from the side of mounting area. Miura teaches the resilient contact area (11b) projecting from the side of mounting area (1). It would have been obvious for one of ordinary skill in the art at the time the invention was made to have added the resilient contact area to application '745's mounting area as taught by Miura to provide space between support and the retaining member to reduce the vibrational energy from touching the support.

The application '745 teaches the mounting area but fails to teach the mounting area has a seating. Miura teaches the mounting area having the seating (1). It would have been obvious for one of ordinary skill in the art at the time the invention was made to have added the seating to application '745 mounting area as taught by Miura to provide connection between the retaining member and fastener for fixing the member on the support.

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The application '745 teaches the retaining area but fails to teach more than one retaining area. Miura teaches two retaining areas (figure 31). It would have been obvious for one of ordinary skill in the art at the time the invention was made to have added more than retaining area to application '745 as taught by Miura to provide additional storage for supporting a pipe on the retaining member.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7-8, 11-12 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 recites the limitation "retaining arm" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 8 line 2, "the support (45)" recite combination and subcombination problem because "the support" is not positively cited in the independent claim 1.

Claim 8 recites the limitation "the level of the side" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 11, line 2, "retaining areas" is indefinite because claim 1 only claims one "retaining area".

Claim 12, lines 1-2, "the overhang" is indefinite and should be changed to ---resilient contact elements--- for clarification.

Claim 15, line 1, "claim 1" should be changed to ---claim 14--- for clarification because independent claim does not have support for "protrusion".

Claim 15, line 2, "the overhang" should be changed to ---the ring shape--- for clarification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 6-17 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent # 6,708,931 to Miura.

Miura teaches the retaining member in plastic (c, col. 3, lines 36-43 and col. 4, lines 48-53) comprising a basic body (22) with a mounting area (1) and a retaining area (27) projecting from at least one side of the mounting area with at least one line seating (28-30). The member comprises a resilient contact area (11b) projecting from the side of the mounting area. The mounting area has a seating (10) oriented transversely to the contact area. The seating has associated therewith inwardly projecting lamellae (25a) of the basic body. The mounting area comprises a box-shape. Each of retaining area has a flat retaining arm (upright part of edge of retaining area) and at least one clipping element (30b) disposed on the flat side of the retaining arm with the line seating. The retaining arm is hollow in part (between 30b and upright part). The retaining area has an increasing distance from the level of the side of the mounting area. The contact area is disposed on a transverse central plane via seating. The contact area has resilient contact elements on diametrically opposed sides of a seating. The resilient contact elements are two ribs and extended in the direction of the retaining area. The resilient contact elements of the contact area beyond the side of the mounting area that requires to be placed on the support decreases toward the retaining area. The rigid basic body is manufactured by rigid plastic material. The line seating is formed in a substantially cylindrical, elastically expandable cup having an insertion slot (triangular shape, opening area between the retaining area and the line seating). The contact area is manufactured from a thermoplastic polymer (col. 3, line 42). The mounting area has at least one rigid protrusion (s) projecting beyond the contact area. The

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protrusion is shape of ring (the head part of s). The ring shape of the protrusion is beyond the side of the mounting area that is placed on a support.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miura.

Miura teaches the retaining area (27, figure 1) but fails to teach the retaining areas project from the two sides of the mounting area, however in figure 31 which is a different embodiment showing that the retaining areas project from the two sides of the mounting area. It would have been obvious for one of ordinary skill in the art at the time the invention was made to have added another retaining area on the other side of mounting area to provide additional retaining area for supporting additional pipe.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miura in view of US Patent Application Publication #2002/0100623 to Thornton.

Miura teaches the line seating but fails to teach the line seating comprising a lining. Thornton teaches the lining (26). It would have been obvious for one of ordinary skill in the art at the time the invention was made to have added lining to Miura's line seating as taught by Thornton to provide protection between the line seating and pipe when retained therein.

Allowable Subject Matter

Claim 19 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art fails to teach at least the lining of the line seating and the resilient contact area are connected to each other via a duct filled with the non-rigid plastic material.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US Patent # 4,467,988 to Kraus

US Patent # 6,290,201 to Kanie et al.

US Patent # 5,947,426 to Kraus

US Patent # 5,033,701 to Kraus

US Patent # 6,070,836 to Battie et al.

US Patent # 5,464,179 to Ruckwardt

US Patent # 5,460,342 to Dore et al.

US Patent # 5,458,303 to Ruckwardt

US Patent Application Publication # 2004/0113027 to Nakanishi

US Patent Application Publication # 2001/0019091 to Nakanishi

US Patent Application Publication # 2002/0063189 to Coudrais

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US Patent Application Publication # 2004/0144897 to Maruyama

US Patent Application Publication # 2004/0065785 to Muira et al.

US Patent Application Publication # 2004/0217236 to Shibuya

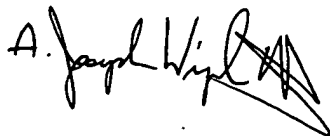
Kraus, Kanie et al., Battie et al, Ruckwardt, Dore et al., Nakanishi, Coudrais, Maruyama, Muria et al. and Shibuya teach a clamp having the line seating and mounting area.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alfred Joseph Wujciak III whose telephone number is (703) 306-5994. The examiner can normally be reached on 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leslie A Braun can be reached on 703 308 2156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Alfred Joseph Wujciak III
Examiner
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12/13/04